



§ DAC  
IFW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 1632	:	
Examiner: Valerie E. Bertoglio	:	
In re application of:	:	Title:
Sergio A. Lira	:	NOVEL USES OF
	:	MAMMALIAN CCR8
Serial No.: 09/780,724	:	RECEPTORS AND
	:	RELATED REAGENTS
Filing Date: February 9, 2001	:	
Patent No.: 6,762,341	:	
Patent Issue Date: 07/13/2004	:	
Attorney Docket No.: JB01066 Q	:	

APPLICATION FOR PATENT TERM ADJUSTMENT  
UNDER 37 C.F.R. § 1.705(d)

Kenilworth, NJ 07033  
July 28, 2004

Mail Stop: Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Application is a request under 37 C.F.R. § 1.705(d) for reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that was issued in the "Issue Notification" of the above-identified application. Applicant submits herewith form PTO/SB/17, which authorizes the USPTO to charge the appropriate fee under 37 C.F.R. § 1.18(e) to applicant's deposit account.

### Background

In accordance with 37 C.F.R. § 1.705(d), if a patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date of issuance.

In the present case, the Notice of Allowance, which has a mailing date of February 23, 2004, was accompanied by a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which indicated that the patent term adjustment is 424 days. The projected issue date of the patent is August 31, 2004. An Issue Notification was mailed on June 24, 2004, which indicated that the patent will issue on July 13, 2004 and that the patent term adjustment is now 310 days. The patent issued on July 13, 2004.

Applicant believes that the patent term reduction from 424 to 310 days was made in error. In addition, applicant believes that this application for patent term adjustment under 37 C.F.R. § 1.705(d) is timely filed, as it is being filed within 30 days of the July 13, 2004 issue date.

### Statement of Facts

In accordance with 37 C.F.R. § 1.702, the above-identified application was filed on February 9, 2001 and is eligible for patent term adjustment.

As stated previously, a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which was issued in conjunction with a Notice of Allowance, indicated that the patent term adjustment for the above-identified application is 424 days.

Applicant calculates the 424 days credit as follows. Applicant filed the above-identified application on February 9, 2001. The first office action, a restriction requirement, was mailed on June 17, 2003. Therefore, the Office failed to mail a notification under 35 U.S.C. § 132 or Notice of Allowance not later than fourteen months after the application filing date, as required by 37 C.F.R. § 1.702(a)(1). According to 37 C.F.R. § 1.703(a)(1), this failure results in 424 credit days.

After receiving the Issue Notification, the undersigned contacted the Office of Patent Legal Administration to inquire why the patent term was reduced from 424 to 310 days. A representative from that office stated that the patent term was reduced by 86 days for filing a miscellaneous paper after receiving the Notice of Allowance and by an additional 28 days for

filing formal drawings after receiving the Notice of Allowance. This resulted in a total of 114 days reduction in patent term from the original calculation of 424 days.

For the following reasons, applicant submits that the above patent term reduction of 86 days was made in error. The miscellaneous paper that the Office is referring to is a Statement of the Substance of the Interview. Applicant filed this Statement because the Interview Summary form (form PTOL-413) required that the Statement be filed. The Interview Summary states that if a reply to the last Office Action has already been filed (applicant filed his response to the last Office Action on December 3, 2003), then applicant is given one month from the interview date (February 17, 2004) or the mailing date of the Interview Summary form (February 23, 2004) to file a Statement of the Substance of the Interview. Applicant filed such a Statement on March 18, 2004. Therefore, applicant filed the Statement in a timely manner. In addition, applicant submits that the filing of the Statement was legally required and does not constitute a failure to engage in reasonable efforts to conclude prosecution under 37 C.F.R. § 1.704.

Applicant also submits that the above patent term reduction of 28 days was made in error. Applicant never submitted drawings during the prosecution of this application. In fact, the application was filed without drawings. In addition, a Preliminary Amendment was filed on December 4, 2002, which deleted all references to figures from the specification.

Applicant further submits that this patent is not subject to a terminal disclaimer.

In conclusion, applicant believes that the reduction of patent term from 424 to 310 days was made in error and that applicant is entitled to a credit of 424 days. Accordingly, reconsideration of the calculation of the patent term adjustment is earnestly solicited.

Respectfully submitted,



Michael G. Biro  
Reg. No. 46,556

Schering-Plough Corporation  
Patent Department  
Mail Stop K-6-1, 1990  
2000 Galloping Hill Road  
Kenilworth, NJ 07033-0530

Phone: (908) 298-5098  
Fax: (908) 298-5388



Patent No. 6,762,341; Issue Date: 07/13/2004

Applic. No.: 09/780,724 Filing Date: 02/09/2001

Applicant: Sergio A. Lira

Title: Novel Uses of Mammalian CCR8 Receptors and Related Reagents

## Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop: PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on July 28, 2004

Date

A handwritten signature in cursive script that reads "Michael Biro".

Signature

Michael G. Biro, Reg. No. 46,556

Typed or printed name of person signing Certificate

**Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.**

Documents enclosed:

Application for Patent Term Adjustment under 37 CFR 1.705(d) - 3 pages

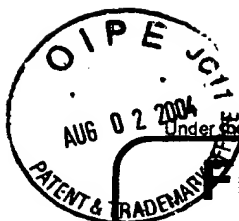
Fee Transmittal form - 1 page IN DUPLICATE

Certificate of Mailing - 1 page

Return Postcard

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL**  
**for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ ) 200.00**Complete if Known**

Application Number	09/780,724
Filing Date	02/09/2001
First Named Inventor	Sergio A. Lira
Examiner Name	Bertoglio, Valerie E.
Art Unit	1632
Attorney Docket No.	JB01066Q

**METHOD OF PAYMENT** (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit  
Account  
Number  
Deposit  
Account  
Name

19-0365

Schering-Plough Corporation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 180	2005 80	Provisional filing fee	

**SUBTOTAL (1)** (\$ )**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	- 3** =	X	
Multiple Dependent			

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2)** (\$ )

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION** (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) Petition 37 CFR 1.18(e)

200.00

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$ ) 200.00**SUBMITTED BY**

(Complete if applicable)

Name (Print/Type)	Michael G. Biro, Reg. No. 46,556	Registration No. (Attorney/Agent)	46,556	Telephone	908-298-5098
Signature	<i>Michael Biro</i>	Date	July 28, 2004		

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS

**SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.